UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,807	08/24/2001	Hideharu Ogawa	45023-1003	2170

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EXAMINER
LIEN, TAN

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 August 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d). The certified copy has been filed in foreign Application No. 2000-

254203, filed on 08/24/2000.

Specification

The title of the invention is not descriptive. A new title is required that is clearly

indicative of the invention to which the claims are directed.

The following title is suggested: "A Custom E-mail Filter to Prevent Unwanted

Messages Using User-Defined Acceptable/Unacceptable List."

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

As to claims 1, 7, 13, and 14 it is not clearly defined in the specification what the

term "public e-mail address" embodies. The Examiner will interpret the term to be any

addresses associated to e-mail including individual e-mail, alias e-mail, group or

distribution list e-mail and many others. All the other claims are rejected by virtue of

their dependencies.

As to claim 6, it is not exactly clear after reading the specification as to what the

rewriter unit function does. For the purposes of applying art, the Examiner will construe

the meaning of the rewriter unit as a unit that rewrite/convert/map the user name with an

e-mail address for returning or replying to the original message.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 7-9 and 13-15 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Drummond et al (US Patent 6,691,156) in view of Olivier (US Patent

6,480,885).

Claim(s) 1, 7, 13, 14: Drummond teaches an e-mail server device which manages user

information including at least one user, and delivers an e-mail to the at least one user

specified in the user information, said device comprising:

a receiver which receives e-mails (FIG. 3, ref. 308);

a transfer unit which transfers, in a case where an address of the received e-mail is an e-mail address of a user specified in user information managed by another e-mail server device, the received e-mail to the another e-mail server device (Applicant admitted art in paragraph [0083] of Pre-Grant Pub. No. 2002/0026488 where SMTP is well known in the art and is used by all e-mail servers including Applicant's application for invention);

an inquiry unit which inquires of the at least one user, in a case where the address of the received e-mail is a public e-mail address of the user specified in the user information managed by the e-mail server device, whether to accept the received e-mail to be delivered from its addresser (FIG. 3, ref. 318 and FIG. 4, ref. 406; Initially when the sender's public e-mail address is not on the list, the system sends an inquiry e-mail and wait for an acknowledgement. When it is acknowledged, the system administrator will check the radio button 406 in FIG. 4 to accept the received e-mail in the holding queue, if the inquiry of the acknowledgement is not successful the system will reject the e-mail and not add to the list); and

a delivery unit which delivers the received e-mail to the user having the public e-mail address, in a case where a delivery condition for delivering the e-mail is satisfied (FIG. 3, ref. 312 & 324).

Drummond, however, fails to teach a notification unit which notifies the addresser that there is no user having the public e-mail address, in a case where the at least one user does not accept the received e-mail to be delivered from the addresser as a result of the inquiry.

Olivier, in an analogous art, teaches rejecting an email message as a result of an inquiry to the subscriber's list and notifying the sender of the rejection with a rejection return email (col. 13, lines 15-20 and FIG. 10(1), ref. 606 & 610). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Drummond's e-mail server with Olivier's notification unit for notifying the sender with a rejecting email not in the subscriber list.

One of ordinary skill in the art would recognize the advantage of including the notification of rejection unit and that it would greatly reduce the quantity of electronic mail and enriches the quality of communication (col. 3, lines 37-60 Olivier).

Claim(s) 15: Drummond and Olivier teach the e-mail server device according to claim 13, wherein

said information recording medium is a computer disk, a floppy disk, a hard disk, a magneto-optical disk, a digital video disk, a magnetic tape, or a semiconductor memory (Official Notice is taken on this claim).

Claim(s) 2, 8: Drummond and Olivier teach the e-mail server device according to claim

1, 7, further comprising

an allowed-addresser recorder which records information representing the

addresser of the received e-mail as an allowed addresser in association with the

public e-mail address, in a case where the at least one user accepts the received

e-mail to be delivered from the addresser as a result of the inquiry (col. 6, lines

55-57 Drummond; wherein the allowed-addresser recorder is the unit that adds

the approved addresses to the verified acceptable list by having the user

checking the "Add Sending Address To All Lists" to accept the addresser of the

received e-mail in association to the public e-mail address. All valid e-mail

addresses on the Internet are considered public even if they are aliases,

distribution list from listservers, and individual e-mail. It is public in a sense that

they are routable to the public Internet), and

wherein the delivery condition is satisfied, in a case where the information

representing the addresser of the received e-mail is recorded as the allowed

addresser on said allowed-addresser recorder in association with a public e-mail

address of the address of the e-mail (col. 6, lines 55-57 Drummond; wherein the

delivery condition is satisfied in order for the system to add the public e-mail

address to the approved list and forwarded to e-mail client).

Claim(s) 3, 9: Drummond and Olivier teach the e-mail server device of claim 1, 7,

further comprising:

an individual-address selector (FIG. 4, ref. 406) which selects an individual e-mail

address managed by said e-mail address server, in association with the

addresser of the e-mail and the user having the public e-mail address

corresponding to the addressee of the received e-mail, in a case where the

received e-mail is accepted to be delivered from the addresser as a result of the

inquiry (FIG. 3, ref. 318 and FIG. 4, ref. 406 Drummond; Initially when the

sender's public e-mail address is not on the list, the system sends an inquiry e-

mail and wait for an acknowledgement. When it is acknowledged, the system

administrator will check the radio button 406 in FIG. 4 to accept the received

public e-mail address in the holding queue corresponding to the addressee of the

received e-mail, if the inquiry of the acknowledgement is not successful the

system will reject the e-mail address in association with the addresser of the e-

mail and not add it to the list);

an individual address informer which informs the addresser of the e-mail about

the selected individual e-mail address (col. 13, lines 15-20 and FIG. 10(1), ref.

606 & 610 Oliver; wherein the individual address informer is the notification unit

taught in claim 1 that informs the individual addresser of the selection done in the

individual-address selector); and

an individual address recorder which records information representing the user

as a target user having the public e-mail address of the received e-mail and

information representing the addresser as an informed-addresser, in association

with the selected individual e-mail address (col. 6, lines 55-57 Drummond;

wherein the individual address recorder is the unit that adds the approved

individual address to the verified acceptable list by having the user checking the

"Add Sending Address To All Lists" to accept the addresser of the received e-

mail in association to the individual e-mail address), and

wherein the delivery condition is satisfied, in a case where the address of the

received e-mail is the individual e-mail address recorded on said individual

address recorder and information representing the addresser of the e-mail is

recorded as an informed addresser, thereby the delivery unit delivers the e-mail

to the user as the target user (col. 6, lines 55-57 Drummond; wherein the delivery

condition is satisfied in order for the system to add the individual e-mail address

to the approved list and forwarded to e-mail client).

Claims 4-5 and 10-11 are are rejected under 35 U.S.C. 103(a) as being

unpatentable over Drummond in view of Olivier and Holleran (US Patent 5,752,059).

Claim(s) 4, 10: Drummond and Olivier teach the e-mail server device of claim 3, 9, but

fail to teach

said individual address selector selects, as an individual e-mail address, an e-mail address generated by converting characters of the public e-mail address of the received e-mail; and

the original public e-mail address is generated from the individual e-mail address as a resultant address of the character conversion, thereby achieving character reverse conversion of the individual e-mail address.

Holleran, in an analogous art, teaches converting characters of the electronic mail and converting it from a field format to a string format and vice versa to achieve the original electronic mail address from the reverse conversion (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Holleran's electronic mail character converter with Drummond and Oliver's e-mail server. One of ordinary skill in the art would recognized that the combination would produce an advantage for ease of use in specifying the e-mail address in either field or string format (Abstract of Holleran), and the conversion would be in a form where it is easily comprehensible (col. 3, lines 26-40).

Claim(s) 5, 11: Drummond, Olivier and Holleran teach the e-mail server device of claim 4, 10, wherein

a predetermined character string is added in a user name of the public e-mail

address, thereby achieving the character conversion of the public e-mail address

(FIG. 11a and 11b, FIG. 12a and 12b of Holleran; In FIG. 11a in the field format,

the name and the zone or domain are added together to convert to a string

format as shown in FIG. 11b in the address textarea. The motivation to combine

is shown in claim 4 as this deals with conversing format).

Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Drummond in view of Olivier and Waskiewicz (US Patent 5,822,526).

Claim(s) 6, 12: Drummond and Olivier teach the e-mail server device of claim 3, 9, and

the transfer unit to forward e-mail outside of the e-mail server, but fails to teach

a rewriting unit which rewrites the public e-mail address of the addresser

specified in the e-mail into the individual e-mail address of the addresser

recorded in association with the addresser and the addressee, in a case where

rewriting conditions that

(i) a public e-mail address of the user specified in the user information

managed by said e-mail server device is specified as the addresser of the

received e-mail, and that

(ii) the individual address recorder records information representing the

addressee of the received e-mail as an informed addresser and

information representing the user having the public e-mail address as a

target user, in association with a corresponding individual e-mail address,

are satisfied.

But is reconstructed to mean "the rewriter unit as a unit that rewrite/convert/map

the user name with an e-mail address for returning or replying to the original

message."

Waskiewicz, in an analogous art, teaches the mapping/rewriting function that

converts the account name to a form compatible with the native protocol of the

gateway to render an email address that identifies the source of the email

message and that the source may be used by the recipient as a return address

(col. 4, lines 29-37 and col. 1, lines 15-30). It would be obvious to one of

ordinary skill in the art at the time of the invention to combine Waskiewicz's

rewriting unit for translating a common account name to e-mail addresses from

different email systems with Drummond and Olivier's e-mail server system, for

the advantage of facilitating and managing the account names with associated

email address from different email systems, and reducing the administration

overhead.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tan Lien whose telephone number is (571) 272-3883. The examiner can normally be reached on Monday-Thursday from 8:30am to 6pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for this Group is (703) 305-3718.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [tan.lien@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER